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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/676,175	09/29/2000	Orna Etzion	42390.P7512	1540

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John P Ward
Blakely Sokoloff Taylor & Zafman LLP
Seventh Floor
12400 Wilshire Boulevard
Los Angeles, CA 90025-1026

EXAMINER

MEONSKE, TONIA L

ART UNIT	PAPER NUMBER
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2183

DATE MAILED: 03/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/676,175	Applicant(s) ETZION, ORNA	
	Examiner Tonia L Meonske	Art Unit 2183	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,8-11 and 13-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,8-11, and 13-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Declaration

"Affidavits or declarations to overcome a rejection ... must be made by the inventor ..." (See MPEP 715.04 I). *The affidavit is not signed and no evidence is supplied to establish that an exception to this general principle applies (See MPEP 715.04 for the exceptions)*

1. The Declaration filed under 37 CFR 1.131 on February 4, 2005 is not properly signed.

According to 37 CFR 1.4 (d)(1):

(1) Each piece of correspondence, except as provided in paragraphs (e) and (f) of this section, filed in an application, patent file, or other proceeding in the Office which requires a person's signature, must:

- (i) Be an original, that is, have an original signature personally signed in permanent ink by that person; or*
- (ii) Be a direct or indirect copy, such as a photocopy or facsimile transmission (§ 1.6(d)), of an original. In the event that a copy of the original is filed, the original should be retained as evidence of authenticity. If a question of authenticity arises, the Office may require submission of the original.*

2. Since the declaration is not properly signed, it does not need to be considered.
3. However, in the interest of advancing prosecution of the case Examiner will provide some guidance regarding the declaration.
4. It appears that the Declaration filed on February 4, 2005 under 37 CFR 1.131 is ineffective to overcome the Rozas et al. reference, US Patent 6,725,361.
5. Applicant is attempting to show conception of invention prior to June 16, 2000, the effective date of Rozas et al., coupled with diligence from June 16, 2000 until September 29, 2000, the date of filing of the instant application.

I. Conception

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred."). See MPEP 715.07 General Requirements

6. To establish conception, the declaration states in numbered paragraph 3 "The invention disclosure describes the operation of generating an expected top of stack during instruction translation, as is described and claimed in our application". This amounts to a vague and general statement. This is not a clear explanation. Thus applicant has not met his burden of clearly showing how the submitted evidence supports conception of the invention.
7. The examiner has reviewed the submitted evidence in its entirety and does not find that it would support conception even with a proper affidavit. For example, it is not obvious to Examiner where the claimed "during the translating, adding at least one instruction to said translated first block of instructions to determine if said first expected TOS is equal to an actual TOS at a time of executing said translated first block of instructions" is supported by the exhibits. As such it appears that Applicant has not shown a conception of invention. This is a single example and is not meant to be comprehensive and exhaustive. Applicant has the burden of establishing conception.

II. Diligence

8. Where conception prior to the reference date has not been clearly established diligence need not be considered [See MPEP 715.07(a).] However, in the interest of expediting prosecution the Examiner will provide further guidance regarding the deficiencies in the attempted showing of diligence.

9. The critical period for which diligence must be shown is from June 16, 2000 of Rozas et al. until September 29, 2000 of filing the instant application. It appears that the evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Rozas et al. reference to a constructive reduction to practice of the instant invention. The entire period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. A 2-day period lacking activity has been held to be fatal. In re Mulder, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); Fitzgerald v. Arbib, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) [See MPEP 2138.06].

10. Applicant has not proven diligence because the periods from June 16, 2000 to June 23, 2000, from June 25, 2000 to July 2, 2000, and from July 4, 2000 to September 29, 2000 are unexplained. However, the timeframe from July 4, 2000 to September 29, 2000 could be corrected with an affidavit from the attorney proving due diligence during that time frame.

11. Of particular concern are: (1) The period from June 16, 2000 to June 23, 2000. Currently, there are no actions alleged or evidence submitted which deal with the critical period starting just PRIOR to the date of the reference to be antedated; and (2) July 4 to September 29 - an 87 day period of inactivity.

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12. Furthermore it is noted that each Exhibit to which applicant refers in the declaration is not clearly labeled. In the declaration Applicant states that "Exhibit A" and "Exhibit B" are attached. However, on the attached documents no headings entitled "Exhibit A" or "Exhibit B" are present on the documents. It is unclear which document is "Exhibit A" and which document is "Exhibit B".

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. Claims 1, 3-6, 8-11, and 13-15 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Rozas et al., US Patent 6,725,361.

15. The rejections are respectfully maintained and incorporated by reference as set forth in the last office action, mailed on June 1, 2004.

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

17. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tonia L Meonske whose telephone number is (571) 272-4170. The examiner can normally be reached on Monday-Friday, 8-4:30.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eddie P Chan can be reached on (571) 272-4162. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tlm


EDDIE CHAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100